

REMARKS

I. General

The issues outstanding in the instant application are as follows:

- Claims 1, 5, 8 through 12 and 14 through 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yamashita et al., U.S. Patent No. 5,555,362 (hereinafter *Yamashita*), in view of Lemay, *Teach Yourself Web Publishing with HTML in a Week* (hereinafter *Lemay*), and further in view of Nielsen, U.S. Patent No. 5,897,644 (hereinafter *Nielsen*).
- Claims 2, 3, 4, 13 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamashita* as modified by *Lemay* and *Nielsen* and further in view of *Borland, QUATTRO PRO User's Guide* (hereinafter *Quattro Pro*).
- Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamashita* as modified by *Lemay* and *Nielsen* and further in view of Oliver, D. et al, *Netscape 3 Unleashed* (hereinafter *Netscape*).

Applicants hereby traverse the outstanding rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1, 10, 11 and 12 have been amended to correct typographical errors and to clarify and emphasize language of these independent claims. Claims 8 and 9 have been amended to reintroduce limitations of "publish" and "preview," respectively, which appear to have been inadvertently removed by an earlier Amendment. The claims have been amended only for the cosmetic purpose of clarifying their meaning and scope, and not for the purpose of narrowing their scope for substantial reasons retailed to patentability. No new matter has been added by these amendments. Claims 1-5 and 8-19 are pending in this application.

II. Nonanalogous Prior Art

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) and M.P.E.P.2141.01(a).

Applicants respectfully contend that *Yamashita* is nonanalogous prior art. The Office Action admits that *Yamashina* does not teach “a web page”. One endeavoring in the field of designing a web page editor program would not be expected to look to the art of optical character recognition to address particular problems dealt with by the present invention such as “preserving a preferred presentation layout of a web page authored on a first computing system and rendered on one or more second computing systems, wherein, said layout is susceptible to influence by browser configuration on said one or more second computing systems” (see claim 1). For at least this reason, the outstanding obviousness rejection of claims 1 through 5 and 8 through 19 should be withdrawn.

Furthermore, applicant respectfully contends that *Quattro Pro* is also nonanalogous prior art. One endeavoring in the field of designing a web page editor program would not be expected to look to a spreadsheet program to address particular problems dealt with by the present invention such as: “receiving input from a user indicating the primary split direction,” (see claim 2); “enabling the size of selected text of the web page to be locked” (see claim 3); “displaying the web page on a display screen, including indications of the locations in of the determined splits” (see claim 4); “wherein the primary split direction is set by the user” (see claim 13); or “code displays the web page indicating the splits” (see claim 18). Therefore, the outstanding obviousness rejection of claims 2, 3, 4, 13 and 18 should be withdrawn.

III. Rejections under 35 U.S.C. §103(a)

Claims 1, 5, 8 through 12, and 14 through 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamashina* in view of *Lemay* and *Nielsen*. Claims 2, 3, 4, 13 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamashina*, *Lemay* and *Nielsen* in view of *Quattro Pro*. Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamashina*, *Lemay* and *Nielsen* in view of *Netscape*.

A. Examiner's Personal Knowledge

In the rejection of claims 2 and 13, the Office Action refers to “the inherent directional nature of selective, orientation.” In the rejection of claim 3, the Office Action states... “implement Quattro Pro’s teachings with Yamashita to lock the size of text, because text size will be fixed when text font style and size are selected” (emphasis added).

Applicants believe that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to these matters. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertions. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite at least one reference in support of the assertions. Otherwise the rejection of claims 2, 3 and 13 should be withdrawn.

B. A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

1. The Office Action does not provide the requisite motivation.

In its obviousness rejection of claims 1, 5, 8 through 12 and 14 through 17, the Office Action admits that *Yamashina* does not teach “a web page”. The Office Action attempts to cure this nonanalogous art deficiency by introducing *Lemay*, which the Office Action alleges to teach having “many web page editors.” The motivation for making the combination was presented as follows:

“It would have been obvious to one of ordinary skill in the computer art at the time of the invention to apply Lemay’s tools to Yamashita’s method because of the tools shown by Lemay, teaching us techniques for coding web pages”.

Further, in respect to the obviousness rejection of claims 1, 5, 8 through 12 and 14 through 17, the Office Action admits that *Yamashita*, as modified by *Lemay*, fails to disclose “preserving preferred web page rendered presentation layouts.” The Office Action attempts to cure this further deficiency in *Yamashita* by introducing *Nielsen*, which the Office Action alleges to teach “a web page presentation system, said original page is changed to fit within

various browser size configurations.” The motivation for making the combination was presented as follows:

“It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Nielsen to Yamashita, because of Nielsen’s taught advantage of preserving Web page layouts, providing Yamashita the advantage of preserving Web layouts accommodating various user preferred browser window sizes.”

The Office Action fails to provide any motivation for modifying the teaching of *Lemay* with those of *Nielsen*. Whereas, *Yamashita* fails to teach “a web page”, as admitted by the Office Action, the stated motivation of “providing Yamashita the advantage of preserving Web layouts” is insufficient, immaterial and irrelevant.

Furthermore, *Lemay* teaches away from the present invention. The third paragraph on page 326 of *Lemay* states: “on the other hand, if you go looking for a full-featured HTML editor that lets you quickly see the result of your work, insert links and anchors and inline graphics quickly and easily, or build a form using element widgets you can drag from a toolbox, you’ll be looking for a very long time” (emphasis added). Thus, *Lemay* teaches that the claimed elements of the present invention, namely, “preserving a preferred layout of said web page when rendered by one or more second computing systems, wherein said preferred layout is susceptible to influence by browser configuration on said one or more second computing systems” are absent from the prior art.

Turning to the obviousness rejection of claims 2, 3, 4, 13 and 18, the Office Action attempts to further supplement *Yamashina* as modified by *Lemay* and *Nielsen* by introducing a fourth reference, the nonanalogous art spreadsheet reference *Quattro Pro*. With respect to claims 2 and 13, the Office Action alleges *Quattro Pro* teaches “a user selecting the print orientation as either Portrait (vertically) or Landscape (horizontally) by a check box.” The motivation for making the combination with respect to claims 2 and 13 was presented as follows:

“It would have been obvious to one of ordinary skill in the art at the time of the invention to apply *Quattro Pro*’s select indication method to *Yamashita*’s input command, because of *Quattro Pro*’s taught advantage of using a check button instead of an input command, and the inherent directional nature of selective, orientation.”

The motivation for making the *Yamashita*, *Lemay*, *Nielsen* and *Quattro Pro* combination with respect to claim 3 was presented as follows:

“It would have been obvious to one of ordinary skill in the computer art at the time of the invention to implement Quattro Pro’s teaching with Yamashita to lock the size of text, because text size will be fixed when text font style and size are selected.”

The only motivation for making the *Yamashita*, *Lemay*, *Nielsen* and *Quattro Pro* combination with respect to claims 4 and 18 was presented as follows:

“So a “view table” would have been an obvious addition to one of ordinary skill in the art at the time of the invention to apply to Yamashita, because a “view table” is the same as a print view button.”

These three statements of motivation fail to provide sufficient motivation to combine a nonanalogous art reference such as *Quattro Pro* with the combination of *Yamashita*, *Lemay* and *Nielsen*, which is itself based on a nonanalogous art reference, *Yamashita*.

Furthermore, concerning the rejection of claim 3 *Quattro Pro* teaches away from the limitation of “enabling the size of selected text of the web page to be locked”. Conversely, at page 122, *Quattro Pro* provides that “Print To Fit (in File | Page Setup) shrinks the print block headers, footers and headings so that they fit on as few pages as possible”. Thus, the stated motivation for combining the fourth reference, *Quattro Pro*, itself a nonanalogous art reference, with the combination of *Yamashita*, *Lemay* and *Nielsen*, which is based on the nonanalogous art reference *Yamashita*, to read on claim 3 is clearly lacking.

Regarding the obviousness rejection of claim 19, the Office Action admits that *Yamashina* as modified by *Lemay* and *Nielsen* does not teach having “specific limitation of frame inclusion with independent split determination per frame”. The Office Action attempts to cure this deficiency by introducing a fourth reference, *Netscape*, which the Office Action alleges to teach “a system of frames, whereby two separate documents are displayed in its own frame of a browser”. The motivation for making the combination was presented as follows:

“It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the document frames system of Netscape to Yamashita, because of Netscape’s taught advantage of frames incorporating independent documents, providing simultaneous display of multiple documents to the segmentation system as taught by Yamashita.”

Applicants respectfully contend that *Netscape* teaches away from the claimed limitation of “wherein the software code determines splits for each frame independently”. On page 409, *Netscape* states: “opening a <FRAMESET> tag requires that the rows and columns and their sizes (either relative or precise) be stated in the <FRAMESET> statement”. Thus *Netscape* teaches away from independence of splits. Thereby undermining the stated motivation for combining *Netscape* with *Yamashita*, *Lemay* and *Nielsen*.

In reference to all the above recited motivations, it is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. The language provided by the Office Action are merely statements that the references can be modified, and do not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Thus, the motivation provided by the Office Action is improper and/or insufficient, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of nonanalogous art reference *Yamashita* with both, *Lemay* and *Nielsen* is desirable. Motivation for combining the alleged teachings of *Nielsen* with the web pages alleged to be taught by *Lemay* is entirely absent from the Office Action. Furthermore, no valid suggestion has been made as to why *Quattro Pro* or *Netscape* should be added to this dubious combination of references based on the nonanalogous art reference *Yamashita*, particularly the addition of a further nonanalogous art reference, *Quattro Pro*. Therefore, the rejection of claims 1-5 and 8-19 should be withdrawn.

2. The recited combination does not teach or suggest all claimed limitations.

As pointed out above, in its obviousness rejection of claims 1, 5, 8 through 12 and 14 through 17, the Office Action admits that *Yamashina* does not teach “a web page”. The Office Action attempts to cure this nonanalogous art deficiency by introducing *Lemay*, which

the Office Action alleges to teach having “many web page editors.” The Office Action further admits that *Yamashita*, as modified by *Lemay*, fails to disclose “preserving preferred web page rendered presentation layouts.” The Office Action attempts to cure this second deficiency by introducing a third reference, *Nielsen*, which the Office Action alleges to teach “a web page presentation system, said original page is changed to fit within various browser size configurations.” However, this combination of three references, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines determining, using a first computing system, a primary split direction for the web page preserving a preferred layout of said web page when rendered by one or more second computing systems. As the Office Action admits *Yamashita* does not disclose these limitations. Further, the Office Action infers that *Lemay* does not teach this limitation by its introduction of *Nielsen*. As shown in FIGURES 9A through 9C of *Nielsen*, and discussed in the abstract, *Nielsen* discloses “a page layout similar to that of the original but magnified or reduced to fit the available display area” (emphasis added). Furthermore, at column 3, lines 32 through 37 *Nielsen* states “the invention specifies the size of the fixed canvas used to create the presentation and transforms (reducing or enlarging) the canvas and image (resulting from processing the HTML data stream) to fit on a display with a different size than the display used to create the original presentation”. Thus, *Yamashita*, even as modified by *Lemay* and *Nielsen* by the Office Action does not teach the claimed “determining, using a first computing system, a primary split direction for the web page,, preserving a preferred layout of said web page when rendered by one or more second computing systems”, of claim 1. Nor does this combination teach “means for determining a primary split direction for the web page, said primary split direction preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other system second system” of claim 10. Similarly the combination does not teach “determining a primary split direction for the web page, preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other computer” as recited in claim 11. Finally, claim 12 recites “device for obtaining a layout of display elements on a web page, and a primary split direction for the web page preserving a preferred layout of said web page when rendered by various web browsers”, which is clearly not taught by the recited combination.

Furthermore, *Lemay* teaches away from the present invention. The third paragraph on page 326 of *Lemay* states: “on the other hand, if you go looking for a full-featured HTML editor that lets you quickly see the result of your work, insert links and anchors and inline

graphics quickly and easily, or build a form using element widgets you can drag from a toolbox, you'll be looking for a very long time" (emphasis added). Thus, *Lemay* teaches that the claimed elements of the present invention, namely, "preserving a preferred layout of said web page when rendered by one or more second computing systems, wherein said preferred layout is susceptible to influence by browser configuration on said one or more second computing systems" are absent from the prior art.

Therefore, the Applicants respectfully assert that for the multitude of reasons presented above independent claims 1, 10, 11 and 12 are patentable over the 35 U.S.C. §103(a) rejections of record.

Claims 2 through 5, 8 and 9 ultimately depend from base claim 1, and thus inherits all limitations of claim 1. Similarly claims 13 through 19 ultimately depend from base claim 12, and thus inherits all limitations of claim 12. As a result, each of dependent claims 2 through 5, 8 and 9 set forth features and limitations not recited by the combination of *Yamashita*, *Lemay* and *Nielsen* as discussed above. Thus, Applicants respectfully assert that for at least the above reasons claims 2 through 5, 8, 9 and 13 through 19 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Turning to the obviousness rejection of claims 2, 3, 4, 13 and 18, the Office Action attempts to supplement *Yamashita*, as modified by *Lemay* and *Nielsen*, by addition of nonanalogous art reference *Quattro Pro*, a fourth reference, to the combination.

With respect to claims 2 and 13, the Office Action alleges *Quattro Pro* teaches "a user selecting the print orientation as either Portrait (vertically) or Landscape (horizontally) by a check box." However, this combination, as presented, does not teach or suggest all limitations of claims 2 and 13.

Claim 2 defines "receiving input from a user indicating the primary split direction". Similarly, claim 13 defines "wherein the primary split direction is set by the user". *Quattro Pro* does not disclose these limitations. As discussed on page 121 *Quattro Pro* discloses that "using Print Orientation (in File | Page Setup), you can specify the direction to print data". Thus, the nonanalogous reference *Quattro Pro* does not teach the claimed "receiving input from a user indicating the primary split direction" or "wherein the primary split direction is set by the user" (emphasis added). Therefore, Applicants respectfully assert that at least for the above reasons claims 2 and 13 are patentable over the 35 U.S.C. § 103(a) rejection of record.

With respect to claim 3, the Office Action alleges *Quattro Pro* teaches “a user selecting text font and size” and alleges that “text size will be fixed when text font style and size are selected.” However, this combination, as presented, does not teach or suggest all limitations of claim 3.

Claim 3 defines “enabling the size of selected text of the web page to be locked” (emphasis added). The nonanalogous reference *Quattro Pro* does not disclose this limitation. *Quattro Pro* makes no mention of locking a size of text at page 77. Conversely, at page 122, *Quattro Pro* states: “Print To Fit (in File | Page Setup) shrinks the print block, headers, footers, and headings so that they fit on as few pages as possible”. Thus, *Quattro Pro* not only does not teach the claimed “enabling the size of selected text of the web page to be locked” (emphasis added) but teaches away from this limitation. Therefore, Applicants respectfully assert that at least for the above reasons claim 3 is patentable over the 35 U.S.C. § 103(a) rejection of record.

With respect to claims 4 and 18, the Office Action alleges *Quattro Pro* “teaches print view button.” However, this combination, as presented, does not teach or suggest all limitations of claims 4 and 18.

Claim 4 defines “displaying the web page on a display screen, including indications of the locations in of the determined splits” (emphasis added). Similarly, claim 18 defines “displays the web page indicating the splits” (emphasis added). The nonanalogous art reference *Quattro Pro* does not disclose these limitations. As discussed on page 129 *Quattro Pro* discloses “you can use File | Print Preview button (in the File | Print dialog box) to see an onscreen preview of how the document will appear”. *Quattro Pro* does not teach the claimed “including indications of the locations in of the determined splits” or “indicating the splits”. Therefore, Applicants respectfully assert that for the above reasons claims 4 and 18 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Regarding the obviousness rejection of claim 19, the Office Action admits that *Yamashina* as modified by *Lemay* and *Nielsen* does not teach having “specific limitation of frame inclusion with independent split determination per frame”. The Office Action attempts to cure this deficiency by introducing a fourth reference, *Netscape*, which the Office Action alleges to teach “a system of frames, whereby two separate documents are displayed in its own frame of a browser”. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 19 defines “wherein the software code determines splits for each frame independently”. *Netscape* does not disclose this limitation. As shown in FIGURE 22.10 of *Netscape*, and discussed at page 408, “each frame contains an individual document that can function independently of the other frames”. Thus, *Netscape* does not teach the claimed “wherein the software code determines splits for each frame independently”.

Furthermore, as discussed above, *Netscape* teaches away from the claimed limitation of “wherein the software code determines splits for each frame independently”. On page 409, *Netscape* states: “opening a <FRAMESET> tag requires that the rows and columns and their sizes (either relative or precise) be stated in the <FRAMESET> statement”. Thus *Netscape* does not teach “splits for each frame” and teaches away from independence of any such splits. Therefore, the Applicants respectfully assert that for the above reasons claim 19 is patentable over the 35 U.S.C. § 103(a) rejection of record.

IV. Conclusion

For at least the reasons given above, Applicants submit that the pending claims distinguish over and differential from the prior art of record under 35 U.S.C. §103(a). Furthermore, Applicants submit that this application is in full condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Dated: June 6, 2002

Respectfully submitted,

By 

Jerry L. Mahurin

Registration No.: 34,661

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue

Suite 2800

Dallas, Texas 75201

(214) 855-8000

(214) 855-8200 (Fax)

Attorneys for Applicant

Version With Markings to Show Changes Made

1. (Thrice Amended) A method for “preserving a preferred presentation layout of a web page authored on a first computing system and rendered on one or more second computing systems, wherein, said layout is susceptible to influence by browser configuration on said one or more second computing systems,” said method, comprising:

obtaining a layout of display elements on a web page;

[with a first computing system,] determining, using a first computing system, a primary split direction for the web page, [for] preserving a preferred layout of said web page when rendered by one or more second computing systems, wherein said preferred layout is susceptible to influence by browser configuration on said one or more [of] second computing systems; and

determining splits of the web page, in the primary split direction [for the web page].

8. (Twice Amended) The method of claim 5, wherein the generating step is performed after receiving a publish request from a user.

9. (Twice Amended) The method of claim 5, wherein the generating step is performed after receiving a preview request from a user.

10. (Twice Amended) A system comprising:

means for obtaining a layout of display elements on a web page;

means for determining a primary split direction for the web page, said primary split direction [for] preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other system second system, wherein said preferred layout is susceptible to influence by browser configuration on said web browsers hosted by at least one other system; and

means for determining splits for the web page, in the primary split direction [for the web page].

11. (Twice Amended) A computer-readable storage medium storing program code for causing a computer to perform the steps of:

obtaining a layout of display elements on a web page;

determining a primary split direction for the web page, [said primary split direction for] preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other computer, wherein said preferred layout is susceptible to influence by browser configuration on said web browsers hosted by at least one other computer; and

determining splits in the web page, in the primary split direction [for the web page].

12. (Twice Amended) A system for preserving a preferred presentation layout of a web page authored on a first computing system and rendered on one or more second computing systems, wherein, said layout is susceptible to influence by browser configuration on said one or more [of] second computing systems, said system comprising:

a device for obtaining a layout of display elements on a web page, and a primary split direction for the web page [, said primary split direction for] preserving a preferred layout of said web page when rendered by various web browsers; and

memory storing software code for determining splits in the web page, in the primary split direction [for the web page].